REMARKS

The Office Action dated October 18, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

STATUS OF THE CLAIMS

Claims 1-30, 32-34, and 37-49 are currently pending in the application, of which claims 1, 12, 21, 27-30, 32-34, and 48-49 are independent claims. Claims 1, 4-30, and 32-34 have been amended, and claims 37-49 have been added, to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 31 and 35-36 have been cancelled without prejudice or disclaimer. Claims 1-30, 32-34, and 37-49 are respectfully submitted for consideration.

CLAIM REJECTIONS UNDER 35 U.S.C. 112

Claim 19 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse this rejection.

The Office Action asserted that claim 19 recites the limitation wherein said APN is decrypted in said authentication server, but the specification states that the parameters are only decrypted at the access point or selected service network. However, the selected service network includes the authentication server (*see* Specification at paragraph [0025], lines 2-7). Also, claim 19, as amended, recites the limitation "wherein said at least one

access point name parameter is decrypted in said processor." One of ordinary skill in the art would recognize that the authentication server is typically equipped with a processor. Thus, there is support for the limitation that "said at least one access point name parameter is decrypted in said processor." Accordingly, Applicants respectfully request that the rejection of claim 19 be withdrawn.

Claims 30 and 32-34 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection.

The Office Action asserted that claims 30 and 32-34 recite the limitations "a data structure," "a computer program product," and/or "a computer readable medium," but these limitations are not included in Applicants' originally-filed disclosure, and therefore constitute new matter. However, this rejection is improper because it appears to rigidly analyze the disclosure in view of the precise words "a data structure" and "a computer readable medium." Instead, the appropriate analysis is whether the specification discloses the concept behind the words.

Section 112 of the Patent Act states that the "specification shall contain a written description of the invention." 35 U.S.C. §112. The Federal Circuit has held that "[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed." *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The Federal Circuit has explained,

however, that "[t]he disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue." *Id. See additionally, Kao Corp. v. Unilever United States, Inc.*, 78 USPQ2d 1257, 1260 (Fed. Circ. March 21, 2006). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement. The concept claimed is fully supported in the specification, in such a way that one of ordinary skill in the art could clearly conclude that the inventor invented what is claimed. Therefore, the claims fully comply with the written description requirement.

The concept of "a data structure, comprising ... a service selection information configured to select a service" is disclosed, for example, in the specification at Figure 4 in which there is disclosure of a message comprising an access point name (APN) parameter configured to specify a requested service. One of ordinary skill in the art would appreciate that the message is for providing "a data structure, comprising a service selection information configured to select a service."

Furthermore, one of ordinary skill in the art would recognize that network elements and functional entities depicted, for example, in Figure 1 of the present application, are typically equipped with "[a] computer-readable storage medium," for example, a memory. Thus, Figures 1 and 4 and the associated discussion in the present application provide full and adequate support for the claim recitations. Accordingly, Applicants respectfully request that the rejection of claims 30 and 32-34 be withdrawn.

Claims 10 and 27 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the invention. Specifically, the Office Action asserted that claim 10 recites the limitation "said APN," and claim 27 recites the limitation "said system," but there is insufficient antecedent basis for the limitations. Applicants have amended claim 10 to depend on claim 8, and have amended claim 27 to recite "[a] system," to provide sufficient antecedent basis for the limitations. Accordingly, Applicants respectfully submit that the rejection of claims 10 and 27 is now moot in view of the amendments.

Reconsideration and allowance of claims 10, 19, 27, 30, and 32-34 are therefore respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 101

Claims 28, 30, and 32-34 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Applicants respectfully traverse the rejection of claim 28. The Office Action asserted that claim 28 was rejected because the method is allegedly not tied to another statutory class, or does not transform underlying subject matter, and thus is not a patent eligible process. However, the method of claim 28 is tied to another statutory class, specifically, the category of "machine." This can be seen explicitly from the recitation of "access point" in claim 28. An access point is a network device that clearly qualifies as a

"machine." In addition, the method of claim 28 is implicitly tied to the apparatus of claim 12 because it recites the same features as those of claim 12.

Furthermore, claim 28 recites operations of extracting and using data, in particular, "a service selection information." These operations involve transformations of the data to different states, and therefore, the method of claim 28 transforms underlying subject matter to different states. Thus, the method is a patent eligible process. Accordingly, Applicants respectfully request that the rejection of claim 28 be withdrawn.

With respect to claims 30 and 32-34, the Office Action asserted that the claims were rejected for allegedly being drawn to a "program" per se, as recited in the preambles. Applicants have amended claims 30 and 32-34 to recite a "computer-readable storage medium." Accordingly, Applicants respectfully submit that the rejection of claims 30 and 32-34 is now moot in view of the amendments.

Reconsideration and allowance of claims 28, 30, and 32-34 are therefore respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 102

Claims 1, 12, 21, and 27-36 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2003/0176188 of O'Neill ("O'Neill"). Applicants respectfully traverse this rejection.

Based on its actual filing date, O'Neill (filed February 3, 2003) is not prior art with respect to the present application since it was filed after October 1, 2002, which is

the priority date for the present application. Applicants note that O'Neill's effective (not actual) filing date would appear to be February 4, 2002, based on its relationship to U.S. Provisional Patent Appln. No. 60/354,195 (the '195 application). Applicants note, however, that the '195 application is quite different, at least in form, from O'Neill. For example, the Figures of the '195 application are substantially different than the Figures of O'Neill. In any event, the '195 application was not published, as provisional applications are not published by the USPTO. Accordingly, for at least these reasons, it is respectfully requested that the rejection be withdrawn as based on a reference that is not prior art under 35 U.S.C. 102(e) or any other statutory section. If the rejection is maintained based on the disclosure of the '195 application, it is respectfully submitted that a *prima facie* rejection must substantiate the rejection with reference to the disclosure of the '195 application, by page and line number of that document.

Reconsideration and allowance of claims 1, 12, 21, 27-30, and 32-34 are therefore respectfully submitted.

CLAIM REJECTIONS UNDER 35 U.S.C. 103

Claims 2-7, 13-16, 22-24, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of U.S. Patent Application No. 2003/0139180 of McIntosh et al. ("McIntosh"). The Office Action took the position that O'Neill discloses all of the elements of the claims, with the exception of the features recited in claims 2-7,

13-16, 22-24, and 26. The Office Action then relies upon McIntosh as allegedly curing these deficiencies in O'Neill. Applicants respectfully traverse this rejection.

As discussed above, O'Neill is not prior art with respect to the present application. Accordingly, it is respectfully requested that the rejection be withdrawn as based on a reference that is not prior art under 35 U.S.C. 102(e) or any other statutory section.

Claims 8-9, 17, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of U.S. Patent Application No. 2002/0107964 of Tomoike ("Tomoike"). The Office Action took the position that O'Neill discloses all of the elements of the claims, with the exception of the features recited in claims 8-9, 17, and 25. The Office Action then relies upon Tomoike as allegedly curing these deficiencies in O'Neill. Applicants respectfully traverse this rejection.

As discussed above, O'Neill is not prior art with respect to the present application. Accordingly, it is respectfully requested that the rejection be withdrawn as based on a reference that is not prior art under 35 U.S.C. 102(e) or any other statutory section.

Claims 10-11, 18, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of Tomoike and further in view of U.S. Patent Application No. 2003/00146464 of Buddhikot et al. ("Buddhikot"). The Office Action took the position that the combination of O'Neill and Tomoike discloses all of the elements of the claims, with the exception of the features recited in claims 10-11, 18, and 20. The Office Action then relies upon Buddhikot as allegedly curing these deficiencies

in the combination of O'Neill and Tomoike. Applicants respectfully traverse this rejection.

As discussed above, O'Neill is not prior art with respect to the present application. Accordingly, it is respectfully requested that the rejection be withdrawn as based on a reference that is not prior art under 35 U.S.C. 102(e) or any other statutory section.

Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neill in view of Tomoike and further in view of U.S. Patent Application No. 2003/0220107 of Lioy et al. ("Lioy"). The Office Action took the position that the combination of O'Neill and Tomoike discloses all of the elements of the claims, with the exception of the features recited in claim 19. The Office Action then relies upon Lioy as allegedly curing these deficiencies in the combination of O'Neill and Tomoike. Applicants respectfully traverse this rejection.

As discussed above, O'Neill is not prior art with respect to the present application. In addition, based on its actual filing date, Lioy (filed April 2, 2003) is not prior art with respect to the present application since it was filed after October 1, 2002, which is the priority date for the present application. Applicants note that Lioy's effective (not actual) filing date would appear to be April 5, 2002, based on its relationship to U.S. Provisional Patent Appln. No. 60/370,442 (the '442 application), or August 29, 2002, based on its relationship to U.S. Provisional Patent Application No. 60/407,469 (the '469 application). In any event, the '442 and the '469 applications were not published, as provisional applications are not published by the USPTO. Accordingly, for at least these reasons, it

is respectfully requested that the rejection be withdrawn as based on references that are not prior art under 35 U.S.C. 102(e) or any other statutory section. If the rejection is maintained based on the disclosure of the '442 and the '469 applications, it is respectfully submitted that a *prima facie* rejection must substantiate the rejection with reference to those disclosures, by page and line number of those documents.

Reconsideration and allowance of claims 2-11, 13-20, 22-25, and 26 are respectfully submitted.

CONCLUSION

For the reasons explained above, it is respectfully submitted that each of claims 1-30, 32-34, and 37-49 recite subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-30, 32-34, and 37-49 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,
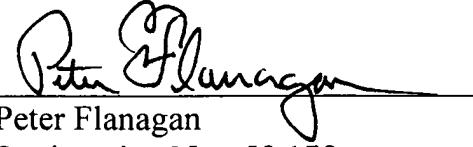
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